

### REMARKS

Reconsideration of the above-identified application as amended respectfully is solicited on behalf of the Applicants.

With the instant response, two (2) claims have been amended.

The outstanding Office Action imposes a restriction requirement between: Group I, claims 1-31; and Group II, claims 32-46. Applicants confirms the provisional election without traverse made by their attorney to elect the Group II claims.

It is noted that claims 32-46 have been rejected under the second paragraph of 35 USC § 112. With the present response, the phrase "greater than said bias" has been deleted from claim 32 so as not to contradict the usage of the term "overpotential."

Claims 32-36, 38-41, and 46-47 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Chen *et al.*, U.S. Pat. Pub. 2002/0119286.

As to the claimed step (c) of independent claim 32, the Examiner is of the opinion that polishing article of Chen is apparently the same as that of the instant application such that the compound layer of Chen would fulfill the intended functional limitations of step (c).

As to those limitations, however, step (c) recites that compound of the layer exhibits an overpotential for the activation of the reaction which is activated by the applied electrical bias.

Looking then to the cited reference, Chen *et al.* discloses [0158] the use of conductive fillers disposed in a binder. One of the fillers mentioned is carbon powder. However, there is authority for the proposition that a claimed species is not rendered *prima facie* obvious solely by the disclosure of an encompassing prior art genus. See *In re Jones*, 21 U.S.P.Q.2d 1941, 1943 (Fed. Cir. 1992) (we decline to extract from *Merck* the rule that the Solicitor appears to suggest -- that regardless of how broad, a disclosure of a chemical genus renders obvious any species that happen to fall within it). In this regard, Fig. 4 of the present application shows that not all metal filled compounds fall within the claimed species of compounds exhibiting a relatively high overpotential.

Chen *et al.*, moreover, appears to be silent as to the effect of overpotential on the performance of the compound in the claimed ECMP process. It is well-settled, however, that an accidental or unwitting duplication of an invention cannot constitute an anticipation. *In re Felton*, 179 U.S.P.Q. 295, 298 (C.C.P.A. 1973), citing *Tilghman v. Proctor*, 102 U.S. 707 (1880); and *Eibel Process Co. v. Minnesota and Ontario Paper Co.*, 261 U.S. 45 (1923). Rather, prior art under either § 102 or § 103 must sufficiently describe the claimed invention to have placed the public in possession of it. *In re Donohue*, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985); *In re Payne*, 203 U.S.P.Q. 245, 255 (C.C.P.A. 1979). Nowhere in Chen *et al.* does there appear to be a recognition that of overpotential as a determining factor in the performance of the compound. Absent such a recognition, it cannot be said that the public heretofore has been placed in possession of the

invention as claimed. Accordingly, it is submitted that claim 32 should be considered to properly distinguish over the prior art.

Dependent claims 33-36, 38-41, and 46-47 further describe the method of claim 9, and should be considered allowable for the reasons given in connection therewith.

Claim 37 has been rejected under 35 USC § 103(a) as being unpatentable over Chen *et al.* in view of the ASM Handbook, Volume 2.

The Examiner has cited the secondary reference as disclosing that tin is an electrically conductive metal that is relatively inert in near neutral solutions. However, neither the primary nor the secondary reference appear to either disclose or suggest the suitability of tin in the formulation of a compound exhibiting the claimed overpotential. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the reason to combine must nevertheless be "clear and particular." *Winner Intern. Royalty Corp. v. Wang*, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000), citing *In re Dembiczak*, 175 F.3d at 994, 999 (Fed. Cir. 1999).

Absent that "clear and particular" reason, the person of ordinary skill in the art would be faced with selecting tin from a host of other electrically conductive metals that are relatively inert in near neutral solutions. Of course, it might be assumed that it is always obvious to interchange materials that are known in the art. Such an assumption, however, would bespeak of the impermissible use of hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *See In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988).

Accordingly, Applicants submit that even if the combination proposed by the Examiner would have been sufficient to render the claimed invention obvious, there has yet to be articulated a suggestion or other motivation in the prior art or otherwise which would have lead one of ordinary skill in the art to have combined the cited references in the manner proposed. Claim 37 therefore is believed to properly distinguish over the prior art.

Claim 42-45 have been rejected under 35 USC § 103(a) as being unpatentable over Chen *et al.* in view of Reinhardt *et al.*, U.S. Patent No. 5,578,362.

The Examiner has cited the secondary reference as disclosing the addition of polyethylene oxide to form a second phase within a continuous phase of the matrix resin.

Looking then to the secondary reference, Reinhardt *et al.* discloses the use of hollow microelements, *i.e.*, microspheres [see col. 6, ll. 19-23], for reducing the rigidity of the surrounding matrix [see col. 6, l. 59, bridging col. 7, l. 3].

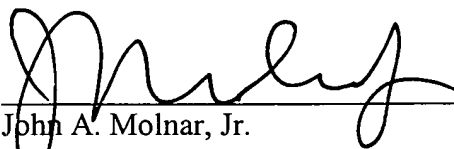
As amended, claim 42 now specifies the discrete domains to be solid as shown in Fig. 3. It is believed that the Reinhardt *et al.* does not fairly suggest the use of such domains for the purposes or controlling rigidity or for any other purpose. Accordingly, claims 42 is submitted to be independently patentable.

Appl. No. Serial No. 10/761,941  
Amdt. dated February 07, 2006  
Reply to Office action of August 9, 2005

Claims 43-45 further describe claim 42, and likewise should be considered allowable.

In view of the foregoing, the issuance of a Notice of Allowance is earnestly solicited.

Respectfully submitted,



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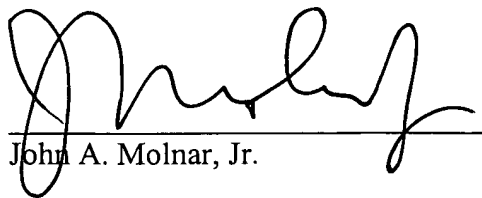
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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence is being deposited on February 07, 2006, with the United Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.



John A. Molnar, Jr.